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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/716,197

11/17/2003

John Phillips

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PATENT LEGAL STAFF
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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,197

Applicant(s)

PHILLIPS ET AL.

Examiner

John M. Winter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15-26, 29-32 and 41-43 is/are rejected.
- 7) ☒ Claim(s) 27, 28 and 33-40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/29/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-43 are pending

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 19, 20, 41 and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 41 and 42 cite "substantially unguessable..." ; claims 19 and 20 cite "substantially large range of possible values..." These limitations recited by these claims are vague and indefinite, no limitation is imposed upon the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 15-18, 21-26, 29-32, 41 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyama et al (US Patent 5,805,699) over Cooper et al. (US Patent 5,563,946)

As per claim 1

Akiyama et al. discloses a method for sharing data with a recipient, the method comprising:

storing the bundle in a bundle store accessible to a bundle server, associating the bundle with a bundle identifier that is substantially unguessable and creating a token corresponding to the bundle, the token comprising the bundle identifier; (Column 3, lines 41-50)

providing the token to a recipient; receiving the bundle identifier at the bundle server from the recipient, using the bundle identifier to identify the bundle, and subsequently returning contents of the bundle to the recipient. (Column 4, lines 4-24)

Akiyama et al. does not explicitly disclose creating a bundle, the bundle comprising information identifying a selection of data to be shared. Cooper et al. discloses creating a bundle, the bundle comprising information identifying a selection of data to be shared (Figure 8) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Akiyama et al.'s method with Cooper et al.'s teaching in order to allow related software products to be purchased and licensed together

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Claims 16, 29, 41 and 43 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 2,

Akiyama et al. discloses a method according to claim 1

comprising identifying a plurality of data files to be shared by receiving selection information from a sharer; wherein the method comprises establishing a communication channel between the bundle server and the recipient and returning contents of the bundle to the recipient comprises providing a copy of the bundle to the recipient by way of the communication channel. (Column 4, lines 4-23)

Claims 22 and 23 are in parallel with claim 2 and are rejected for at least the same reasons.

As per claim 3

Akiyama et al. discloses a method according to claim 2

wherein the selection information identifies a plurality of data files to be shared. (Column 4, lines 8-15)

As per claim 4

Akiyama et al. discloses a method according to claim 2

Official Notice is taken that "providing the token to the recipient is performed by way of a communication mechanism different from the communication channel" is common and well known in prior art in reference to electronic equipment. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a communication mechanism (i.e. ethernet card) is different from the communication channel (i.e. TCP/IP) because the structure of networks differentiates between network devices and protocols.

As per claim 5

Akiyama et al. discloses a method according to claim 2

Official Notice is taken that "token is provided to the recipient as an attachment to an e-mail communication" is common and well known in prior art in reference to electronic transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize email to send a token because this is an inexpensive and reliable manner to deliver information.

As per claim 6

Akiyama et al. discloses a method according to claim 3

Akiyama et al. does not explicitly disclose wherein the token comprises a token file of a type associated with a token redeemer wherein, selection of the token file invokes the token redeemer. Cooper et al. discloses wherein the token comprises a token file of a type associated with a token redeemer wherein, selection of the token file invokes the token redeemer (Column 3, lines 61-67 – column 4 line 1) It would be obvious to one having ordinary skill in the art at the

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time of the invention to combine Akiyama et al.'s method with Cooper et al.'s teaching in order to automate the redemption process

As per claim 7

Akiyama et al. discloses a method according to claim 1 comprising providing the token to a plurality of recipients and repeating redeeming the token for two or more of the plurality of recipients. (Column 4, lines 4-23 – Examiner notes that the mere duplication of a process does not merit patentability)

As per claim 8

Akiyama et al. discloses a method according to claim 1.

Akiyama et al. does not explicitly disclose associating the bundle with a bundle identifier comprises creating a bundle identifier having a value selected from among at least 10^{20} possible values. Cooper et al. discloses associating the bundle with a bundle identifier comprises creating a bundle identifier having a value selected from among at least 10^{20} possible values. (Column 3, lines 9-18) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Akiyama et al.'s method with Cooper et al.'s teaching in order to accommodate a large number of bundles without duplicating a name.

Claim 21 is in parallel with claim 8 and is rejected for at least the same reasons.

As per claim 9

Akiyama et al. discloses a method according to claim 1

Akiyama et al. does not explicitly disclose associating the bundle with a bundle identifier comprises creating a bundle identifier having a value selected from among at least 10^{30} possible values. Cooper et al. discloses associating the bundle with a bundle identifier comprises creating a bundle identifier having a value selected from among at least 10^{30} possible values. (Column 3, lines 9-18) It would be obvious to one having ordinary skill in the art at the time of the invention to combine Akiyama et al.'s method with Cooper et al.'s teaching in order to accommodate a large number of bundles without duplicating a name.

As per claims 10-12

Akiyama et al. discloses a method according to claim 2

Official Notice is taken that "maintaining a ratio of a number of the possible values to a number of bundles in the bundle store to be at least $10^{20} : 1$ " is common and well known in prior art in reference to databases. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a value would have a high ratio of values v/s possible values in order to populate a database without danger of key duplication. A database that use a license number 20 or 15 digits in length as a key would easily maintain this ratio, also a large license would be nearly impossible to "guess" (i.e. brute force crack) and could therefore meet the limitations of claim 12 as well

As per claim 13

Akiyama et al. discloses a method according to claim 1

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wherein returning the bundle to the recipient is performed automatically based solely upon information from the token. (Column 4, lines 4-24)

As per claim 14

Akiyama et al. discloses a method according to claim 1 comprising including in the token a plurality of token resources, the token resources each identifying a corresponding one of a plurality of data items in the selection of data. (Column 4, lines 4-24)

Claims 24, 25 and 26 are in parallel with claim 14 and are rejected for at least the same reasons.

As per claim 15

Akiyama et al. discloses a method according to claim 14 comprising receiving from the recipient a request for a subset of the data items of the selection of data wherein and returning the contents of the bundle to the recipient comprises providing copies of the subset of the data items to the recipient. (Column 4, lines 4-24)

As per claim 17

Akiyama et al. discloses a method according to claim 16 wherein creating the bundle comprises: storing the bundle in a bundle store, the bundle store associated with a bundle store sharer identity, the bundle store sharer identity being unique among a plurality of bundle store sharer identities corresponding to a plurality of bundle stores accessible to the bundle server, the bundle store containing one or more bundles, corresponding to a sharer, the sharer having a sharer identity, matching the bundle store sharer identity. (Column 4, lines 4-23)

As per claim 18

Akiyama et al. discloses a method according to claim 17 wherein the bundle store is associated with a bundle store key pair generated by an asymmetric encryption system, the key pair including a bundle store public key and a bundle store private key wherein creating the token comprises including the bundle store public key in the token. (Figure 6)

As per claim 30

Akiyama et al. discloses a method according to claim 16 comprising, before providing the token to the recipient, encrypting the token so that the token can be decrypted with the use of a pass-phrase. (Figure 6)

As per claim 31

Akiyama et al. discloses a method according to claim 16 wherein creating a bundle comprises: generating a bundle key; encrypting at least a part of the bundle using the bundle key; and, storing the bundle key in the token. (Figure 6)

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As per claim 32

Akiyama et al. discloses a method according to claim 18

wherein communicating with the bundle server comprises: receiving one or more communications at the bundle server, the communications encrypted with the bundle store public key; and sending one or more communications from the bundle server, the communications encrypted with the bundle store private key. (Figure 6)

Allowable Subject matter

Claims 27,28, 33-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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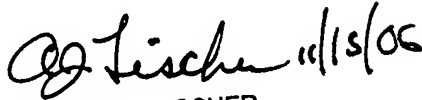
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John Winter

Patent Examiner -- 3621



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